

REMARKS

The above-referenced application has been reviewed in light of the Office Action mailed May 2, 2005. By the present amendment, the Applicant has amended claims 1, 20, 26, 27, 37, 38, 49, 59, 78, and 91. Claims 6, 24, and 80 were canceled in a previous amendment while claims 7, 9, 12, 14, 43-46, and 85-88 were withdrawn in the Office Action as being drawn to a non-elected species. It is respectfully submitted that the claims pending in the application do not introduce new subject matter, are fully supported by the specification, and are patentable over the prior art. Prompt and favorable consideration of these claims is earnestly sought.

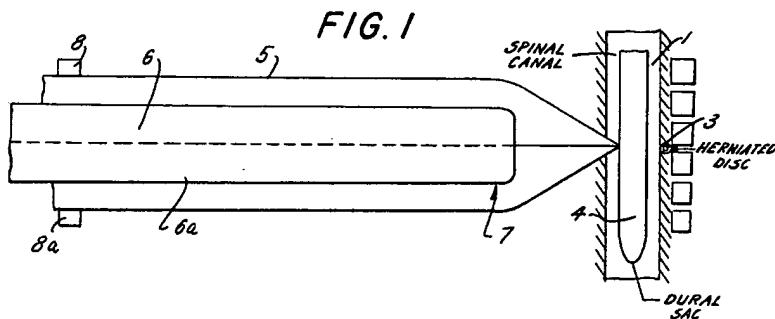
In the Office Action, claims 1, 8, 10, 11, 13, 15-19, 27-30, 38-42, 48-51, 53-55, 59-62, 64-70, 72, and 73 were rejected under 35 U.S.C. § 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 3,417,745 to Sheldon (the '745 patent). The Office Action stated that the '745 patent discloses the steps of providing a retractor having a distal portion and an expandable body coupled to the distal portion, positioning the expandable body between adjacent vertebrae, and expanding the expandable body to spread the adjacent vertebrae apart. In the alternative, the Office Action asserted that it would have been obvious that the creation of this space between the vertebrae spreads the adjacent vertebrae apart since the space that is created is between the vertebrae.

As presently amended, claims 1, 27, and 38 recite a method including the step of, *inter alia*, providing an apparatus having an expandable bladder, while claim 59 recites a method including the step of, *inter alia*, introducing a bladder into the joint. Further still, claims 1 and 27 recite that the expandable bladder includes "surfaces configured to engage and spread adjacent vertebrae apart" while claims 38 and 59 recite that the expandable bladder includes

"surfaces configured to engage and spread adjacent surfaces apart."

The device of the '745 patent is introduced into the spinal canal using a needle such that the device may be used to visually observe a herniated disc. Specifically, the '745 patent discloses (see Column 3, lines 10-19 and Figure 1 reproduced below) that

[a]fter the needle has been inserted, spinescope 7 is introduced into the lumen of the needle and is pushed into it until its distal end reaches the end of the needle 5b. This is done under visual control and the examiner will see the grey shadow of dura (which is the outer covering of the spinal sac) when the spinescope enters the spinal canal. As shown in the drawing 1, the herniated disc 3 is usually located on the opposite side of the spinal canal 1 and usually cannot be seen at this time.



The '745 patent discloses that the spinescope includes a housing having two inflatable members attached to a distal region thereof. The housing is adapted for receiving an endoscope therein. Specifically, the inflatable members of the '745 patent are adapted for urging soft tissue away from the distal end of the housing allowing an improved view of the area through the endoscope or to create an open space in soft tissue for advancing the housing. Specifically, the '745 patent discloses (see Column 5, lines 49-54 and Figure 3 reproduced below)

[i]t was found that in many examinations the spinal fluid was turbid and impaired is [sic] visibility. I have solved this problem by the construction in which an inflatable transparent member is mounted at the distal end of the spinescope. The inflated member 50 displaces the turbid spinal fluid and produces thereby a clear field of vision.

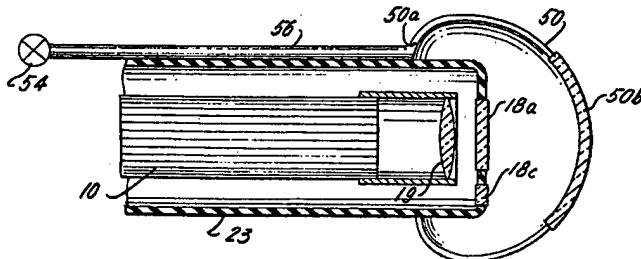


FIG. 3

In addition, the '745 patent discloses (Column 8, line 74-Column 9, line 23 and Figure 4 reproduced below) that "[i]n some cases it was found necessary to provide an adequate space between the optical viewing system such as 19, or 19c, and the examined part" and that "[t]he inflation of the member 57 causes separation of the examined part from the distal end of the spinescope." Furthermore, the '745 patent discloses that "[t]his is the situation in the extra-dural space in the spinal canal which normally does not have any open space but only a potential space to be created by a pressure against the organs which occupy it." The examined part referred to in the '745 patent is a herniated disc which is formed from soft tissue.

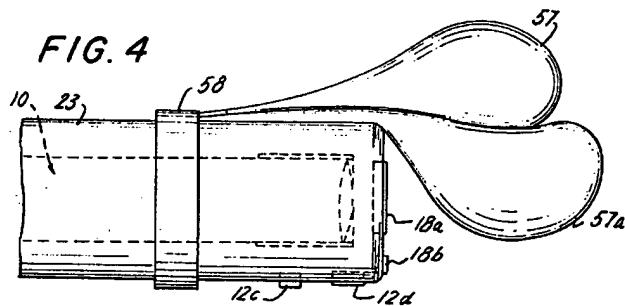


FIG. 4

Essentially, the '745 patent discloses a device and a method for viewing a herniated disc by using an inflatable member to displace soft tissue and/or fluid that may exist in the viewing path of the spinescope. Therefore, the '745 patent does not disclose or suggest a method including the step of, *inter alia*, providing an apparatus having an expandable bladder wherein the expandable bladder includes "surfaces configured to engage and spread adjacent vertebrae apart" as recited in amended claims 1 and 27. In addition, the '745 patent does not

disclose or suggest a method including the step of, *inter alia*, introducing a bladder into the joint wherein the expandable bladder includes "surfaces configured to engage and spread adjacent surfaces apart" as recited in amended claims 38 and 59. Therefore, it is respectfully submitted that claims 1, 27, 38, and 59 are not anticipated or suggested by the '745 patent and that the rejection of these claims has been overcome. Since claims 8, 10, 11, 13 and 15-19 depend directly or indirectly from amended claim 1, claims 28-30 depend directly or indirectly from amended claim 27, claims 39-42, 48-51 and 53-55 depend directly or indirectly from amended claim 38, and claims 60-62, 64-70, 72 and 73 depend directly or indirectly from amended claim 59, it is respectfully submitted that these claims are also not anticipated or suggested by the '745 patent.

In the Office Action, claims 2-5, 20-23, 25, 26, 31-37, 52, 63, 71, 74, 78, 79, 82-84, and 89-101 were rejected under 35 U.S.C. § 103 (a) as obvious over the '745 patent. The Office Action stated that the '745 patent does not specifically disclose operating on a herniated disc, but asserted that it would have been obvious to remove the herniated disc during the procedure disclosed in the '745 patent. In addition, the Office Action stated that it would have been obvious to apply a vacuum to the bladder for quickly deflating it.

As discussed hereinabove, the '745 patent relates to a device adapted for urging soft tissue away from the distal end of an endoscope and does not anticipate or suggest the method recited in claim 1. Since claims 2-5 depend from claim 1, it is respectfully submitted that claims 2-5 are allowable over the prior art.

Claim 20 recites a method including the step of, *inter alia*, providing an apparatus having "an expandable bladder coupled to the distal portion" of the apparatus wherein the expandable

bladder includes "surfaces configured to engage and spread adjacent vertebrae apart" and "inflating the expandable bladder to spread the adjacent vertebrae apart." As discussed hereinabove, the '745 patent does not suggest a method including the step of providing an apparatus having an expandable bladder wherein the expandable bladder includes "surfaces configured to engage and spread adjacent vertebrae apart" and "inflating the expandable bladder to spread the adjacent vertebrae apart" as recited in amended claim 20. Therefore, it is respectfully submitted that the method recited in claim 20 is not suggested by the '745 patent and the rejection of the Office Action has been overcome. Claims 20-23, 25, and 26 depend from claim 20 and it is respectfully submitted that these claims are also allowable over the prior art.

Claim 78 recites a method for working within a bone joint including the step of, *inter alia*, "providing an apparatus having an expandable bladder" wherein the expandable bladder includes "surfaces configured to engage and spread adjacent surfaces apart" and "inflating the expandable bladder to spread the adjacent surfaces to enlarge a working space in said joint." As discussed hereinabove, the '745 patent relates to a device adapted for urging soft tissue away from the distal end of an endoscope and does not suggest a method including the step of, *inter alia*, "providing an apparatus having an expandable bladder" wherein the expandable bladder includes "surfaces configured to engage and spread adjacent surfaces apart" and "inflating the expandable bladder to spread the adjacent surfaces to enlarge a working space in said joint" as recited in amended claim 78. Therefore, it is respectfully submitted that claim 78 is not suggested by the '745 patent. Since claims 79, 82-84, and 89-101 depend from claim 78, it is respectfully submitted that these claims are also allowable over the prior art.

As discussed hereinabove, amended claims 27, 38, and 59 are not anticipated or suggested by the '745 patent. Since, claims 31-37 depend from claim 27, claim 52 depends from claim 38, and claims 63, 71, and 74 depend from claim 59, it is respectfully submitted that these claims are also allowable over the prior art.

The Office Action rejected claims 56-58, 75-77, and 81 under 35 U.S.C. § 103 (a) as obvious over the '745 patent in view of U.S. Patent No. 4,501,266 to McDaniel (the '266 patent). According to the Office Action, the '745 patent does not disclose that the device may be used in a knee, but that the '266 patent discloses that the knee is an area of the body requiring surgical intervention and stated that it would have been obvious to use the device of the '745 patent in a knee. Claims 56-58 depend from amended claim 38, claims 75-77 depend from amended claim 59, and claim 81 depends from amended claim 78. As discussed hereinabove, the '745 patent does not anticipate or suggest the method recited in amended claims 38 and 59, and does not suggest the method recited in amended claim 78.

Adding the disclosure of the '266 patent does not overcome the deficiencies of the '745 patent and does not suggest a method including a bladder that includes "surfaces configured to engage and spread adjacent surfaces apart" as recited in amended claims 38, 59, and 78. Therefore, it is respectfully submitted that these claims are also allowable over the prior art.

The Office Action rejected claims 1-5, 8, 10, 11, 13, 15-23, 25-42, 48-79, 81-84, and 89-101 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,017,305. The Applicant will submit a suitable terminal disclaimer upon indication that claims 1-5, 8, 10, 11, 13, 15-23, 25-42, 48-79, 81-84, and 89-101 are otherwise allowable.

Appl. No. 10/729,668
Amdt. dated June 23, 2005
Reply to Office Action mailed May 2, 2005

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims pending in the application, namely claims 1-5, 8, 10, 11, 13, 15-23, 25-42, 47-79, 81-84, and 89-101, are in condition for allowance. Should the Examiner desire a telephonic interview to resolve any outstanding matters, he is sincerely invited to contact the undersigned at (631) 501-5713.

Respectfully submitted,


Dana A. Brussel
Reg. No. 45,717
Attorney for Applicant

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road - Suite 225
Melville, New York 11747
Tel.: (631) 501-5713
Fax: (631) 501-3526

Send correspondence to:
Chief Patent Counsel
Tyco Healthcare Group
150 Glover Avenue
Norwalk, CT 06856